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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,166	06/17/2002	Robert E. Harms	95304875	6867

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EXAMINER

HWANG, VICTOR KENNY

ART UNIT	PAPER NUMBER
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3764

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/064,166	Applicant(s) HARMS ET AL.	
	Examiner Victor K. Hwang	Art Unit 3764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2002 and 01 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
4a) Of the above claim(s) 19-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☒ Claim(s) 17-24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>20050319</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20021101</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 17-24 are objected to because of the following informalities: the claims as filed are all filed as claim 17. A fax of the claims filed was transmitted to Malin, Haley & DiMaggio on March 07, 2005 as part of a restriction requirement. It was explained that the claim numbering was not correct and that presumably, within claim 17 were claims 18-24. This was confirmed and this examination of the application presumes that there exists claims 18-24, though formally, the claims have not been filed.

Appropriate correction is required.

Allowable Subject Matter

2. The indicated allowability of claims 12-17 during an interview on March 18, 2005 is withdrawn in view of the newly discovered reference(s) to *Hahn* (US Pat. 2,452,458).

Rejections based on the newly cited reference(s) follow.

Election/Restrictions

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-18, drawn to the exercise device, classified in class 482, subclass 106.
- II. Claims 19-24, drawn to the method of forming an exercise device, classified in class 482, subclass 106.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by casting without drilling.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Joseph England on March 07, 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-18.

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 19-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 4, 6, 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Brice* (US Pat. 5,628,716) in view of *Lefebvre* (FR 1,263,930). *Brice* discloses a dumbbell comprising central handle with near and far ends 24, wherein each end has a geometric shape (annular) and a central threaded bore 28 at least partway through each end. One or more weights are provided with a central void 32 of a shape complementary to the geometric shape of the central handle. A threaded bolt 60 secures the weight to the handle by screwing into the threaded central bore. A washer 58 is located between the locking bolt and the weight. The handle is generally cylindrical. A protrusion 20 defines an inner weight stop.

Brice does not disclose each weight comprising an interior element providing tight tolerance with the handle, the interior element having a circumference, and a generally central void of a shape complementary to the geometric shape of the handle.

Lefebvre discloses a weight plate comprising an interior element 2. The interior element is a metal cylinder that provides reinforcement to the hub of the weight plate, when the weight plate is mounted to a weight bar.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the weight plate of *Brice* with the interior element of *Lefebvre*, in order to provide reinforcement to the hub of the weight plate.

Brice as modified by *Lefebvre* is silent as to how the weight is formed around the interior element (claim 11). The claimed phrase “wherein the weight is formed by casting liquid metal in a mold around the interior element” is being treated as a product by process limitation; that is, that the weight and interior element of *Brice* as modified by *Lefebvre* are formed by casting liquid metal in a mold around the interior element. As set forth in MPEP 2113, product by process claims are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 USC 102/103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. See MPEP 2113.

Thus, even though *Brice* as modified by *Lefebvre* is silent as to the process used to form the weight and interior element, it appears that the product in *Brice* as modified by *Lefebvre* would be the same or similar as that claimed.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Brice* (US Pat. 5,628,716) in view of *Lefebvre* (FR 1,263,930) as applied to claim 4 above, and further in view of *Kestila* (US Pat. 6,336,894 B1). *Brice* as modified by *Lefebvre* discloses the invention as claimed except for the weight further comprising a centrally located recession on the outside surface at least the circumference of the washer.

Kestila discloses a dumbbell comprising a weight resistance plate 52 having a centrally located recession 62 on the outside surface at least the circumference of the washer 66,68. The recession is a counter-bore to accommodate the washer (col. 8, lines 52-53).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the weight resistance plate of *Brice* as modified by *Lefebvre* with the outer, central recession of *Kestila*, in order to provide a counter-bore to accommodate the washer.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Brice* (US Pat. 5,628,716) in view of *Lefebvre* (FR 1,263,930) as applied to claim 1 above, and further in view of *Landfair* (US Pat. 6,099,443). *Brice* as modified by *Lefebvre* discloses the invention as claimed except for welding the interior element to the end of the handle.

Landfair discloses that it is old to secure a weight the handle of a dumbbell by welding (col. 3, lines 16-31).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to secure the interior element of the weight to the end of the handle by welding, since *Landfair* discloses welding of a weight to the end of a handle is old in the exercise art.

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Brice* (US Pat. 5,628,716) in view of *Lefebvre* (FR 1,263,930) as applied to claim 1 above, and further in view of *Miller* (US Pat. 3,022,073). *Brice* as modified by *Lefebvre* discloses the invention as

claimed except for the weight resistance plate having a depression generally located on the inside surface to correspond to the protrusion on the handle.

Miller discloses a weight resistance plate 22 having a depression 26 on the inside surface to accommodate the protrusion 30. The protrusion permits selective positioning of an inner stop to accommodate a selective number of weight resistance plates.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the weight resistance plate and bar of *Brice* as modified by *Lefebvre* with the inner depression and selective protrusion of *Miller*, in order to permit a selective number of weight plates to be carried by the handle ends.

11. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Brice* (US Pat. 5,628,716) in view of *Lefebvre* (FR 1,263,930) as applied to claim 1 above, and further in view of *Pinard* (FR 2,600,541 A1). *Brice* as modified by *Lefebvre* discloses the invention as claimed except for the geometric shape of the end of the handle being generally rectangular (claim 8); the geometric shape formed by cutting sides lengthwise into the end of the handle (claim 9).

Pinard discloses a handle with ends 1 having a polygonal geometric shape cross-section and weight plates 4 having a corresponding polygonal geometric shaped opening to fit into the ends of the handle so that the weight plates do not rotate relative to the ends of the handle.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the handle ends and weight plate openings of *Brice* as modified

by *Lefebvre* with corresponding polygonal shapes as taught by *Pinard*, so that the weight plates do not rotate relative to the handle ends.

A rectangular shape would have been an obvious design choice since a rectangle is a polygon and a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

Pinard is silent as to how the polygonal shape of the ends of the handle are formed. The claimed phrase “wherein the geometric shape is formed by cutting sides lengthwise into the end of the handle” in claim 9 is being treated as a product by process limitation; that is, that the geometric shape of the handle ends of *Pinard* are formed by cutting sides lengthwise into the ends of the handle. As set forth in MPEP 2113, product by process claims are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 USC 102/103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. See MPEP 2113.

Thus, even though *Pinard* is silent as to the process used to form the polygonal geometric shape, it appears that the product in *Pinard* would be the same or similar as that claimed; especially since both applicant’s product and the prior art product are made of metal.

12. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Brice* (US Pat. 5,628,716) in view of *Lefebvre* (FR 1,263,930) as applied to claim 1 above, and further in view of *Martinez* (US Pat. 5,484,367). *Brice* as modified by *Lefebvre* discloses the invention as claimed except for the geometric shape being irregular.

Martinez discloses handle 16 having ends 24 with an irregular geometric shape 26 with weights 18 having a corresponding irregular geometric shaped opening 30 so that the weights are precluded from rotating relative to the handle 16 (col. 4, lines 3-10).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the geometric shape of *Brice* as modified by *Lefebvre* with the irregular shape of *Martinez*, in order to preclude rotation of the weight relative to the handle bar.

13. Claims 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Brice* (US Pat. 5,628,716) in view of *Lefebvre* (FR 1,263,930) as applied to claim 1 above, and further in view of *Hahn* (US Pat. 2,452,458). *Brice* as modified by *Lefebvre* discloses the invention as claimed except for pins connecting the interior element to the resistance (claim 12); the interior and resistance comprise one or more complementary apertures whereby the pins connect the interior element to the resistance (claim 13); the circumference of the interior element and the circumference of the void in the resistance are generally circular (claim 14); the pins comprise a tight tolerance (claim 15); the pins are made of steel (claim 16); and the interior element is made of steel (claim 17).

Hahn discloses a hub structure comprising a hub 6 having an inner circular void to receive a hub adaptor 1. A pair of diametric recesses 12 are provided at the junction between the inner circumference of the void in the hub and the outer circumference of the hub adaptor so as to receive a pair of pins 11. This connection provides a non-rotatable connection between the hub and the hub adaptor so that the hub adaptor is then mounted to a shaft.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the interior element and weight of *Brice* as modified by *Lefebvre* with the connection of *Hahn*, in order to provide a non-rotatable connection between the interior element and the resistance so that the interior element can then be placed over the end of the handle.

Brice as modified by *Lefebvre* and *Hahn* discloses the claimed invention except for the interior element and pins made of steel. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the pins and interior element of steel material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

14. Claims 1, 6 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Thorne* (US Pat. 5,266,069) in view of *Lefebvre* (FR 1,263,930). *Thorne* discloses an exercise device comprising a generally cylindrical, central handle 12 having near and far ends 28,30, each end having a geometric shape (circle is a geometric shape) and a central bore. An endplate 36 includes at least one nipple 40 to be placed over an outer surface of a weight 14,16 wherein the outer surface of the weights includes at least one void complementary to each nipple.

Thorne does not disclose each weight having an interior element having a central void of a shape complementary to the geometric shape of the central handle (claim 1).

Lefebvre discloses a weight plate comprising an interior element 2. The interior element is a metal cylinder that provides reinforcement to the hub of the weight plate, when the weight plate is mounted to a weight bar.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the weight plate of *Thorne* with the interior element of *Lefebvre*, in order to provide reinforcement to the hub of the weight plate.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Krudop (US Pat. 1,270,034), *Ayd* (US Pat. 1,326,013), *Hsu* (US Pat. 6,224,520 B1), *Suarez et al.* (US Pat. 6,261,211 B1), *Landfair* (US Pat. Pub. 2004/0072662 A1), *Guillier* (FR 2,459,056), *Hattori* (JP 09299505A), *Choe* (KR 2002078531A) and *Bolton* (GB 2,397,254) disclose exercise devices with various features incorporated in the claimed invention.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor K. Hwang whose telephone number is (571) 272-4976.

The examiner can normally be reached Monday through Friday from 7:30 AM to 4:00 PM Eastern time.

The facsimile number for submitting papers directly to the examiner for informal correspondence is (571) 273-4976. The facsimile number for submitting all formal correspondence at this time is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Huson can be reached on (571) 272-4887.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Victor K. Hwang
March 20, 2005

JEROME W. DONNELLY
PRIMARY EXAMINER

